UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,694	01/26/2001	Christopher M. Connors	M-9723 US	6814

33438	7590	09/01/2006

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EXAMINER
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ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/770,694	CONNORS ET AL.
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 July 2006</u>.

2a)☒ This action is **FINAL**.　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35,37,39-43,45-48,51-62 and 64-74* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35,37,39-43,45-48,51-62 and 64-74* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 January 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/31/2006</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-13, 15-35, 37, 39-43, 45-48, 51-62, and 64-74 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-13, 15-23, and 73

Claims 1, 6, 19, and 73 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith (U.S. Patent 6,901,430). As per claim 1, Smith discloses a

computer system to provide one or more product selections to a user in accordance

with an analysis of product related data provided by the user, the computer system

comprising: a database storing product configuration information, wherein the product

configuration information comprises product identifier information corresponding to

product attribute information for multiple product configurations (column 7, lines 8-21;

column 8, lines 43-62; and column 10, lines 14-27); and a processor (column 7, lines 1-

7). Smith does not expressly disclose a memory to which the processor is coupled, but

not only would the database require a memory, but Smith's disclosure of one or more

computer programs running on a suitable computer processor or processors (column 7,

lines 1-7) inherently requires a memory coupled to the processor wherein the one or

more computer programs are stored. Smith further discloses receiving product related

data from the user through a communication link coupled between a data processing

system of the user and a data receiving module (column 7, line 63, through column 8,

line 62); a filter service module to (i) receive one or more product attributes and (ii)

identify one or more product configurations stored in the database that each include the

one or more product attributes, if the product related data represents the one or more

product attributes (column 10, lines 14-27); a configuration service module to (i) receive

a product identifier and to (ii) identify each combination of attributes stored in the

database that corresponds to the product identifier, if the product related data

represents the product identifier (column 8, lines 24-62; column 10, lines 14-27); and a

presentation module to (i) provide each identified product configuration to the user via

the communication link if the product related data represents the one or more product

attributes (column 10, lines 14-27; Figure 5) and (ii) provide one or more product

selections to the user via the communications link (column 8, lines 24-62; column 10,

lines 14-27; Figure 5). Smith does not quite expressly disclose that, if the product

related data represents the product identifier, each product selection represents a

product identifier and a respective combination of attributes identified as corresponding

to the product identifier, but the description of searching for a match or a near match for

an identified product (column 8, lines 56-59) implies that the product selections each

represent a product identifier and a respective combination of attributes identified as

corresponding to the product identifier.

Smith does not disclose that the various modules are stored in the memory, but

given a program of programs running on suitable computer processors, as disclosed,

the sections of programming which cause Smith's system to carry out its functions can

be viewed as modules stored in memory.

As per claim 6, Smith discloses that the database contains product identifier

information that identifies each product configuration and reference data that links the

one or more product attributes to a product configuration (column 8, lines 24-62; column

10, lines 14-27).

As per claim 19, Smith discloses that the database contains product identifier

information (column 8, lines 24-62; column 10, lines 14-27).

As per claim 73, Smith discloses that the product related data includes data

related to a vehicle (e.g., column 8, lines 24-42).

Claims 4, 5, 13, 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 1 above, and

further in view of official notice. As per claim 4, Smith does not expressly disclose a

needs analysis module to process the received product related data, but some form of

data processing would be inherent to enable the system to use the received product

related data to search inventory, etc. Smith does not disclose that the needs analysis

module determines which type of information is included in the received product related

data, but official notice is taken that it is well known to determine which kind of

information is included in data. Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to have a

needs analysis module determine which type of information is included in the received

product related data, for the obvious advantage of deciding what action to take in

response to the product related data.

Smith does not expressly disclose that the filter service module is configured to

provide a product identifier to said needs analysis module in response to one or more

product attributes received from said needs analysis module, but discloses that a

product is identified in response to a product attribute or attributes, and also that the

product identifier identifies an existing (pre-generated) product, and the attribute

information is an attribute of the product (column 8, lines 24-62; column 10, lines 14-27).

Hence, it would have been obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention for the filter service to be appropriately

configured, in order to carry out the disclosed functions of Smith's invention.

As per claim 5, Smith discloses that the filter service is configured to use said

one or more product attributes to retrieve the product identifier from the database

(column 8, lines 24-62; column 10, lines 14-27).

As per claim 13, Smith discloses permitting identification of at least one pre-generated product configuration based on product identifier information (column 8, lines 24-62; column 10, lines 14-27). For the obviousness of the needs analysis module, see the rejection of claim 4 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

As per claim 15, Smith does not expressly disclose that the configuration service module is configured to provide a configuration list to the needs analysis module in response to a product identifier received from the needs analysis module, but one can define whatever software module is involved in providing lists of the attributes of the various products in Smith's system as a configuration service, and Smith does disclose comparing product identifiers identifying products with configuration/attribute data for products, to determine which products match listed attributes (column 8, lines 24-62; column 10, lines 14-27). For the obviousness of the needs analysis module, see the rejection of claims 4 and 13 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

As per claim 16, Smith does not expressly disclose that said configuration list is a list of the available product attributes of said product, but such a list of available product attributes would have been obvious for the purpose of enabling Smith's system to carry out its function of determining which, if any, available products match user-desired attributes (column 8, lines 24-62; column 10, lines 14-27).

As per claim 17, Smith does not expressly disclose that said configuration list is a list of the configurations of said product, but such a list of configurations would have

been obvious for the purpose of enabling Smith's system to carry out its function of

determining which, if any, available products match user-desired attributes (column 8,

lines 24-62; column 10, lines 14-27).

As per claim 18, Smith does not expressly disclose that the configuration service

is configured to use the product identifier to generate the configuration list from

information stored in the database, but given that configuration/attribute information for

products stored in the database are compared to attributes to determine which products

match listed attributes (column 8, lines 24-62; column 10, lines 14-27), generating such

configuration lists is held to be obvious, to make the system able to carry out its

functions.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith

(U.S. Patent 6,901,430) as applied to claim 1 above, and further in view of Neuborne et

al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle

Those Wares Online?"). Smith does not disclose a software configuration engine stored

in the memory to generate the pre-generated product configurations, but Neuborne

teaches modifying product configurations by choosing options (paragraph beginning,

"The program lets MasterCard slap its logo") which implies generating the basic

configurations, and perhaps the configurations as modified by options, if there are a

limited number of options, leading to choices of vehicles configured in advance. Hence,

it would have been obvious to one of ordinary skill in the art of electronic commerce at

the time of applicant's invention to have the computer system include a software

configuration engine to generate the pre-generated product configurations, for the

obvious advantage of being able to present configurations and options to a user.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith

(U.S. Patent 6,901,430) as applied to claim 1 above, and further in view of Neuborne et

al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle

Those Wares Online?"). Smith does not disclose that the data receiving module is

further configured to receive data indicating a user selected product, wherein the

selected product corresponds to one of the identified product configurations, and the

data receiving module is further configured to receive product configuration selections

from the user to further configure the selected product, but Neuborne teaches receiving

product configuration selections from a user to further configure a selected product, and

generating configured product data as selected (paragraph beginning, "The program

lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to have the

data receiving module thus configured, for the obvious advantage of enabling the user

to configure the selected product according to his own wishes.

Neuborne does not expressly teach that the presentation module is further

configured to present the configured product data to the user via the communication

link, but does teach an interactive design shop and an online order form; official notice

is taken that it is well known to present descriptions of what is being purchased on

online order forms. Hence, it would have been obvious to one of ordinary skill in the art

of electronic commerce at the time of applicant's invention to present the configured

product data to the user via the communication link, for the obvious advantage of

enabling the user to assure himself of what he had ordered.

Claims 7, 8, 9, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 6 above, and

further in view of the Microsoft Press Computer Dictionary. As per claim 7, Smith

discloses the product configurations being pre-generated product configurations

(column 8, lines 43-62). Smith does not disclose that the database comprises a

configuration table storing the pre-generated product configurations, and an attribute

table storing the product attribute information, but the Microsoft Press Computer

Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2,

page 459). Hence, it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of applicant's invention to have the database comprise

tables, specifically a configuration table and an attribute table, for the obvious

advantage of linking relevant data, and enabling efficient access.

As per claim 8, Smith does not expressly disclose that the configuration table

contains the product identifier, but the use of tables being obvious (as set forth above,

regarding claim 7), storing this particular kind of information in the configuration table

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention.

As per claim 9, Smith does not disclose that the tables comprise records

comprising fields which contain corresponding information (attribute information in an

attribute field, etc.), but the Microsoft Press Computer Dictionary teaches the use of

fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the tables comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 10, Smith discloses that said configuration information describes a configuration of a product; said attribute information describes an attribute of a product; and said configuration of said product includes said attribute of said product (column 8, lines 24-62), and for the product to actually exist in inventory, etc., its configuration must be allowable.

As per claim 11, Smith discloses that the needs analysis module is configured to access the configuration information through the filter service module (column 8, lines 24-62; column 10, lines 14-27).

As per claim 12, Smith discloses by inherency that a reference to a configuration record allows the filter service to access the configuration record according to attribute information, and therefore to access attribute records using attribute information (column 8, lines 24-42; column 10, lines 14-27).

Claims 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) as applied to claim 19 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 20, Smith does not disclose that the database comprises a configuration table containing said product identifier and said product configuration information, but the Microsoft Press Computer

Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, specifically containing identifier information and configuration information, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 22, Smith does not disclose that the configuration table comprises a configuration record comprising pre-generated product configurations and identifier fields which contain corresponding information, but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the configuration table comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 23, Smith discloses that said configuration information describes a configuration of the product, and product identifier information identifies the configuration of the product (column 8, lines 24-42; column 10, lines 14-27). Smith further discloses can configure and save product configurations (column 10, lines 28-48).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and the Microsoft Press Computer Dictionary as applied to

claim 20 above, and further in view of official notice. Smith discloses that the needs analysis module is configured to access the configuration information, and that the configuration service module is configured to access the database (column 8, lines 24-42; column 10, lines 14-27). Smith does not expressly disclose that the needs analysis module supplies product identifier information to the configuration service (as well as to the user of the system), or that the configuration service module uses product identifier information to access the database. However, this is a mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier information (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service. For the obviousness of the needs analysis module, see the rejections of claims 4 and 13 above; official notice is taken that it is well known for computer programs to determine which module (e.g., subroutine) to provide data to.

Claims 24-35, 37, 39-48, and 74

Claims 24, 25, 37, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). Claims 24, and 74 are essentially parallel to claims 1, and 73, respectively, and rejected on essentially the same grounds; claim 37 is narrower than claim 15, and rejected on similar grounds.

As per claim 25, Smith discloses a computer permitting identification of a product based on product attributes, implying code for doing so (column 8, lines 24-42; column 10, lines 14-48).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as

applied to claim 24 above, and further in view of Neuborne. Claim 26 is essentially

parallel to claims 3, and rejected on essentially the same grounds.

Claims 27, 28, and 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith and Neuborne as applied to claim 24 above, and further in

view of official notice. Claims 27, 28, and 29 are essentially parallel to claims 4, 5, and

6, respectively, and rejected on essentially the same grounds.

Claims 39, 40, 41, 42, and 43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith and as applied to claim 24 above, and further in view of official

notice. AS per claim 39, Smith does not expressly disclose a needs analysis module to

process the received product related data, but some form of data processing would be

inherent to enable the system to use the received product related data to search

inventory, etc. Smith does not disclose that the needs analysis module determines

which type of information is included in the received product related data, but official

notice is taken that it is well known to determine which kind of information is included in

data. Hence, it would have been obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention to have a needs analysis module

determine which type of information is included in the received product related data, for

the obvious advantage of deciding what action to take in response to the product related

data. Even this is unnecessary if one does not read a description of what a needs

analysis module does from claim 4 (for example) into claim 39. Smith discloses a

computer system analyzing needs (column 8, lines 24-42; column 10, lines 14-27),

which implies that the code comprises a needs analysis module.

Claims 40-43 are closely parallel to claims 15-18, respectively, and rejected on

essentially the same grounds.

Claims 30, 31, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith, Neuborne, and official notice as applied to claim 29 above,

and further in view of the Microsoft Press Computer Dictionary. Claims 30, 31, 32, 33,

and 35 are essentially parallel to claims 7, 8, 9, 10, and 12, respectively, and rejected

on essentially the same grounds. As per claim 34, Smith discloses accessing product

configuration identifier information using said attribute information (column 8, lines 24-

42; column 10, lines 14-27).

Claims 45, 46, 47, and 48 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith, Neuborne, and official notice as applied to claim 29 above,

and further in view of the Microsoft Press Computer Dictionary. As per claim 45, Smith

discloses that the data structure contains product identifier information (column 8, lines

24-62; column 10, lines 14-27). Smith does not disclose that the data structure

comprises a configuration table containing said product identifier information, but the

Microsoft Press Computer Dictionary teaches the use of tables in databases (definition

of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention to

have the database comprise a configuration table, for the obvious advantage of linking

relevant data, and enabling efficient access.

As per claim 46, Smith discloses accessing the product configuration information, and accessing the database (column, 24-42; column 10, lines 14-27). Smith does not expressly disclose the code by supplying the product identifier information to a configuration server, and using the product identifier to access the database, but this is held to be mere verbal reshuffling. One can describe whatever module of Smith's system is involved in receiving the product identifier (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service.

As per claim 47, claim 47 is essentially parallel to claim 22, and rejected on essentially the same grounds.

As per claim 48, Smith discloses that the product configuration information describes a configuration of the product, and product identifier information identifies a pre-generated configuration of the product (column 8, lines 24-42; column 10, lines 14-27). For product configurations to be stored as packages (column 8, lines 40-42), and still more to actually exist in inventory (column 8, lines 44-62), the product configurations may be presumed to be allowable in accordance with applicable product rules governing allowable combinations of product attributes.

Claims 51-62 and 64-69

Claims 51, 52, 53, 57, 58, 59, 64, 65, 66, 67, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430). As per claim 51, Smith discloses a method to provide one or more product selections to a user in

accordance with product related data provided by the user, the method comprising:

receiving the product related data from the user through a communication link coupled

between a data processing system of the user and a computer system (column 7, lines

8-21; column 7, line 63, through column 8, line 62); receiving one or more product

attributes and identifying one or more product configurations stored in a database that

each include the one or more product attributes, if the product related data represents

the one or more product attributes (column 10, lines 14-27); receiving a product

identifier and identifying each combination of attributes stored in the database that

corresponds to the product identifier, if the product related data represents the product

identifier (column 8, lines 24-62; column 10, lines 14-27); providing each identified pre-

generated product configuration as a product selection to the user via the

communication link if the product related data represents the one or more product

attributes (column 8, lines 43-62; column 10, lines 14-27). Smith does not quite

expressly disclose that, if the product related data represents the product identifier,

each product selection represents a product identifier and a respective combination of

attributes identified as corresponding to the product identifier, but the description of

searching for a match or a near match for an identified product (column 8, lines 56-59)

implies that the product selections each represent a product identifier and a respective

combination of attributes identified as corresponding to the product identifier.

As per claim 52, Smith discloses that the product identifier information identifies

pre-generated product configurations, and the pre-generated product configuration

represents a product having one or more of the attributes (column 8, lines 24-62).

As per claim 53, Smith does not expressly disclose causing a needs analysis

module to provide said attribute to said filter service, and causing said filter service to

return said product identifier to said needs analysis module, but this essentially follows

from regarding the filter service as having a distinct needs analysis module, which

amounts to designating certain circuits, or certain lines of computer code as a "needs

analysis module." This need involve no substantive difference from Smith, and is

therefore held to be obvious. (To make separable is considered to be within the level of

ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent

Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522

[CCPA 1961].)

As per claim 57, Smith discloses providing the product identifier to a

configuration service; identifying the pre-generated product configuration corresponding

to the product identifier by causing the configuration service to query a database using

the product identifier; and causing the configuration service to return the identified pre-

generated product configuration (column 8, lines 24-62; column 10, lines 14-36).

As per claim 58, the product configurations are pre-generated product

configurations, and the product identifier is associated with a pre-generated product

configuration in the database (column 8, lines 24-62; column 10, lines 14-36).

As per claim 59, claim 59 is rejected as obvious on essentially the same basis as

claim 53. Smith does not expressly disclose causing a needs analysis module to

provide said product identifier information to said filter service, and causing said filter

service to return said pre-generated product configuration to said needs analysis

module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which amounts to designating certain circuits, or certain lines of computer code as a "needs analysis module." This need involve no substantive difference from Smith, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; *In re Dulberg*, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

As per claim 64, Smith discloses that the product related data includes data related to a vehicle (e.g., column 8, lines 24-42).

As per claim 65, Smith discloses that the product configuration selections comprise a make of said vehicle (e.g., column 8, lines 24-42).

As per claim 66, Smith discloses that the product configuration selections comprise a model of said vehicle (e.g., column 8, lines 24-42).

As per claim 67, Smith discloses that the product configuration selections comprise a trim level of said vehicle (e.g., column 8, lines 24-42).

As per claim 68, Smith discloses that the product configuration selections comprise an equipment level of said vehicle (e.g., column 8, lines 24-42).

As per claim 69, Smith discloses that the product configuration selections comprise one of a price range, a vehicle type, an engine type, a fuel economy, an interior feature, and a safety feature (e.g., column 8, lines 24-42).

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claim 51 above, and further in view of the Microsoft Press Computer

Dictionary. As per claim 54, Smith discloses querying a database of the computer

system (column 8, lines 24-42); identifying at least one database record comprising the

product identifier and attribute identification; and identifying a pre-generated product

configuration associated with attribute information (column 8, lines 24-62). Smith does

not disclose accessing an attribute table of said database using said one or more

attributes; and accessing said product database record in a configuration table of said

database, but the Microsoft Press Computer Dictionary teaches the use of tables in

databases (definition of table, senses 1 and 2, page 459). Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention to have the database comprise an attribute table and a

configuration table, and access those tables, and the data therein, for the obvious

advantage of linking relevant data, and enabling efficient access.

As per claim 55, Smith discloses that the product identifier is associated with the

pre-generated product configuration, and each pre-generated product configuration

represents a product having said one or more attributes (column 8, lines 24-62).

As per claim 56, claim 56 is rejected on the same basis as claim 54.

Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Smith as applied to claim 57 above, and further in view of the Microsoft Press

Computer Dictionary. As per claim 60, Smith does not disclose accessing a

configuration table of said database using product identifier to identify said pre-

generated product configuration, but the Microsoft Press Computer Dictionary teaches

the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, and access that tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 61, Smith discloses that each pre-generated product configuration is associated with a product identifier (column 8, lines 24-62; column 10, lines 14-36).

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent 6,901,430) and official notice as applied to claim 51 above, and further in view of Neuborne et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle Those Wares Online?"). Smith discloses receiving data indicating a user selected product, wherein the selected product corresponds to one of the identified pre-generated product configurations (column 8, lines 40-62). Smith does not disclose receiving product configuration selections from the user to further configure the selected product, but Neuborne teaches receiving product configuration selections from a user to further configure a selected product, and generating configured product data as selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such selections, for the obvious advantage of enabling the user to configure the selected product according to his own wishes.

Neuborne does not expressly teach generating configured product data corresponding to the product configuration selections configured product data to the user via the communication link, but does teach an interactive design shop and an

online order form; official notice is taken that it is well known to present descriptions of

what is being purchased on online order forms. Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce at the time of applicant's invention

to generate such configured product data, and present the configured product data to

the user via the communication link, for the obvious advantage of enabling the user to

assure himself of what he had ordered.

Claims 70-72

Claims 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Smith (U.S. Patent 6,901,430). As per claim 70, Smith discloses an apparatus to

provide one or more product selections to a user in accordance with product related

data provided by the user, the apparatus comprising: means for receiving the product

related data from the user through a communication link coupled between a data

processing system of the user and a computer system (column 7, lines 8-21; column 7,

line 63, through column 8, line 62); means for processing the received product related

data using resources of the computer system (column 7, lines 1-7; column 8, lines 24-

62); means for receiving one or more product attributes and identifying one or more pre-

generated product configurations stored in a database that each include the one or

more product attributes, if the product related data represents the one or more product

attributes (column 10, lines 14-27); receiving a product identifier and identifying each

combination of attributes stored in the database that corresponds to the product

identifier, if the product related data represents the product identifier (column 8, lines

24-62; column 10, lines 14-27); and means for providing each identified pre-generated

product configuration as a product selection to the user via the communication link if the

product related data represents the one or more product attributes (column 8, lines 43-

62; column 10, lines 14-27). Smith does not quite expressly disclose that, if the product

related data represents the product identifier, each product selection represents a

product identifier and a respective combination of attributes identified as corresponding

to the product identifier, but the description of searching for a match or a near match for

an identified product (column 8, lines 56-59) implies that the product selections each

represent a product identifier and a respective combination of attributes identified as

corresponding to the product identifier.

As per claim 72, Smith discloses that the product related data includes data

related to a vehicle (e.g., column 8, lines 24-42).

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith

(U.S. Patent 6,901,430) as applied to claim 70 above, and further in view of Neuborne

et al. ("BRANDING ON THE NET: The Old Rules Don't Apply. So How Do You Hustle

Those Wares Online?") and official notice. Smith discloses receiving data indicating a

user selected product, wherein the selected product corresponds to one of the identified

pre-selected product configurations (column 8, lines 40-62). Smith does not disclose

receiving product configuration selections from the user to further configure the selected

product, but Neuborne teaches receiving product configuration selections from a user to

further configure a selected product, and generating configured product data as

selected (paragraph beginning, "The program lets MasterCard slap its logo"). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have the apparatus comprise means for receiving such

selections, for the obvious advantage of enabling the user to configure the selected

product according to his own wishes.

Neuborne does not expressly teach generating configured product data

corresponding to the product configuration selections configured product data to the

user via the communication link, but does teach an interactive design shop and an

online order form; official notice is taken that it is well known to present descriptions of

what is being purchased on online order forms. Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce at the time of applicant's invention

to have the apparatus comprise means for generating such configured product data,

and presenting the configured product data to the user via the communication link, for

the obvious advantage of enabling the user to assure himself of what he had ordered.

It is noted that claims 70-72 use "means for" language. Nonetheless, they are

not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35

U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that

effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a
> means or step for performing a specified function without the recital of
> structure, material or acts in support thereof, and such claim shall be
> construed to cover the corresponding structure, material, or acts described
> in the specification and equivalents thereof.

Response to Arguments

Applicant's arguments filed July 7, 2006, have been fully considered but they are

not persuasive. Much the same ground as before appears to be in dispute, so

Examiner's prior arguments bear repeating:

Applicant's arguments against the rejections under 103 all depend on
one basic point, that Smith, the primary reference relied upon, does not teach
a separate and distinct "filter service module" and "configuration service
module". Examiner replies that while the same sections of the Smith patent
are, as Applicant argues, relied upon to teach both modules, this is not
sufficient to make Applicant's claimed invention distinct and non-obvious.
First, claim 1 does not expressly recite any requirement that the filter service
module and configuration service module be separate and distinct, so the
same module in a prior art system can be used to anticipate or render
obvious both. (Similarly, claim 51, for example, does not require that the
processing and identifying steps be entirely distinct.) Secondly, even if the
independent claims were amended, or narrowly interpreted, to require two
distinct modules, the elements would still be considered obvious. As noted
above in the rejections of claims 53 and 59, to make known parts separable
has been held to be within the level of ordinary skill in the art. Thirdly, if the
primary reference does not disclose both of two elements of a claim, the
claim can properly be rejected as obvious if another reference teaches the
missing element (given motivation to combine, etc.). Thus, there is surely at
least as strong a case to find a claim obvious if both of the elements are
disclosed and suggested by a single prior art reference, even if they are not
distinguished in quite the way claimed by the applicant.

To respond to the specifics of Applicant's current arguments, Applicant argues

that Smith discloses only one method of a user identifying product selections, wherein

the user enters desired configuration and options, after which the system performs a search for matching products in the database. This contrasts with Applicant's description of Applicant's invention, where the user can enter either one or more product attributes or else the product identifier. Examiner replies that while Smith does not disclose these as separate and distinct modes of operating Smith's system, it would be quite possible to shift emphasis within Smith's disclosed system, so as to meet the limitations of either form of Applicant's claimed invention. As per column 8 of Smith, a consumer may specify leather seats, a V10 engine, and other attributes, leading to a vehicle which matches, or near-matches, the entered criteria being selected; or the consumer may identify a vehicle as a Ford Excursion, with other identifying information, and have a matching vehicle be recommended. Smith does not draw a sharp distinction between these different modes, apparently leaving it to the customer's discretion to enter whatever information the customer considers important, but that does not make either mode new and distinct over Smith.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-

272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
August 29, 2006